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10/777,009

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EXAMINER

BARHAM, BETHANY P

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/777,009
Filing Date: February 11, 2004
Appellant(s): XU ET AL.

Andrew J. Hagerty
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/02/2006 appealing from the Office action
mailed 04/05/2006.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The prior art relied on is US 5,587,156 ('156) in view of WO 02/087519 A2 ('519).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,587,156 ('156) in view of WO 02/087519 ('519).

- '156 teach shaving compositions and methods of using said shaving compositions (abstract). The compositions advanced by '156 comprise a wetting agent, a cleansing agent, and an insoluble particulate additive (claim 1). About 0.1% to about 20% of the insoluble particulate additive can be added to the shaving composition (claims 6-7). According to '156, the particulate material can comprise polytetrafluorethylene (claim 8, column 6, lines 37-46). The particulate material can be between 10 - 1000 microns (claims 3-5). The shaving composition may be in the form of a gel or cream (abstract). Based on claims 1-8, it is the examiner's position that the composition is substantially free of anionic polymers.
- '156 does not teach a shaving composition comprising a polyethylene oxide and natural or synthetic gum water-soluble polymer.

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- '519 teach shaving compositions comprising polyethylene oxide and natural or synthetic gum water-soluble polymers (abstract and page 5, lines 2-7). According to '519, the shaving compositions can comprise 0.005 to 10% of the water-soluble polymer and the molecular weight of the polymer can be over a million (abstract and page 5, lines 27-36). If added to the composition set forth by '156, the particulate material and water soluble polymer can be present in a ratio between 0.25:1 to about 3:1.
- According to '519, it is beneficial to add polyethylene oxide and natural or synthetic gum water-soluble polymers to a shaving composition because they "interact synergistically to substantially increase the stress ratio of the shaving composition, thereby reducing the coefficient of friction between the cartridge and the razor" (page 5, lines 2-7). This enhances shaving performance (page 1, lines 4-9). Because the addition of polyethylene oxide and natural or synthetic gum water soluble polymers to a shaving cream lotion enhances shaving performance, one of ordinary skill in the art would have been motivated to add polyethylene oxide and natural or synthetic gum water soluble polymers to the composition advanced by '156. Based on the teachings of '519, there is a reasonable expectation that the addition of polyethylene oxide and natural or synthetic gum water-soluble polymers to a shaving cream lotion would enhance shaving performance. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add polyethylene oxide and

natural or synthetic gum water-soluble polymers to the invention advanced by '156 in view of the teachings of '519.

(10) Response to Argument

Appellant argues that '156 in view of '519 fails to establish a *prima facie* case of obviousness for the following reasons (A and B):

(A) That there is no motivation to combine '156 and '519 to impart improved lubricity and glide. Further, applicant mistakenly states that '156 "fails to disclose inclusion of a water soluble polymer" (appeal brief, pg. 4, last paragraph).

The examiner respectfully disagrees with this assertion. Applicant's argue that there is no *prima facie* case of obviousness and no motivation to combine '156 and '519, and the examiner respectfully points out that applicant's argue against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It should be noted that the motivation to combine references can be different from the ones set forth by Applicant. That is, as long as motivation exists to combine the elements, the problem to be solved does not have to involve the same reason for

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making the shaving composition. As such, the examiner respectfully submits that there is motivation to combine the teachings of '156 and '519 as both teach shaving compositions comprising a water soluble polymer, especially since the water soluble polymers disclosed in '519 "interact synergistically to substantially increase the stress ratio of the shaving composition, thereby reducing the coefficient of friction between the cartridge and the razor" (page 5, lines 2-7) and that this enhances shaving performance (page 1, lines 4-9).

Further, '156 teach a composition comprising a known water soluble polymer, PVP (see examples 1-2).

(B) '156 in view of '519 does not teach a method of shaving comprising applying a composition with a lubricating particle to water soluble polymer ratio of about either 0.1:1 to about 10:1 or a ratio of about 0.25:1 to 3:1 to the skin.

The examiner respectfully disagrees with this assertion. With respect to the ratio of water soluble to water insoluble polymers, it is the examiner's position that both '156 and '519 provide motivation for one of skill in the art to meet the ratios advanced in the instant claims 1 and 4. As set forth in '156, 0.12 by weight of PVP may be used in the shaving composition (See examples 1-2). Based on the 0.1% to about 20% by weight of insoluble polymers advanced in '156, it is the examiner's position that one of ordinary skill in the art at the time the invention was made would have the ability to modify the amount of water insoluble particles such that the ratio of water soluble polymer and

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water insoluble particles are within the range of the instant claims 1 and 4 (claim 6 and column 3, lines 30-41). This is because the amount of water insoluble polymers can be varied from 0.1% to about 20% based on particular application so long as the particles are present in an amount capable of providing support for a razor blade (column 3, lines 31-36). For example, if 0.1% of water insoluble particle was used with 0.12% of PVP, the ratio would be 1:1.2, an amount that falls within the range advanced by the instant claims 1 and 4.

It is the examiner's position that '519 also provides motivation for varying the amount of water soluble polymer in the shaving composition set forth in '156. As a general matter, according to '519, it is beneficial to add polyethylene oxide and natural or synthetic gum water-soluble polymers to a shaving composition because they "interact synergistically to substantially increase the stress ratio of the shaving composition, thereby reducing the coefficient of friction between the cartridge and the razor" (page 5, lines 2-7). This enhances shaving performance (page 1, lines 4-9). Specifically, '519 remarks that the amount of water soluble polymer is preferably between 0.1 to 5% (column 5, lines 27-37 and examples 1-18). Moreover, the amount of water soluble polymers varies on the basis of whether the shaving composition is a gel, cream, foam, or lotion (page 5, lines 27-37 and examples 1-18). If added to the composition set forth by '156, the particulate material and water soluble polymer can be present in a ratio between 0.25:1 to about 3:1.

As such, one of ordinary skill in the art at the time the invention was made would have the ability to modify the amount of water soluble polymer on the basis of whether

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the composition is a gel, cream, foam, or lotion (page 5, lines 27-37). Thus, it is the examiner's position that one of ordinary skill in the art would have the ability to vary the ratio of water soluble polymer to insoluble particles based on the desired stress ratio (in excess of 3.0, 4.0, or 5.0) as well as an amount such that the particles are present in an amount capable of providing support for a razor blade (column 3, lines 31-36 of '156 and page 5, lines 27-37 of '519). On this basis and considering the teaching of Examples 1-18, the ratio of insoluble particles and water soluble polymer would fall within the range of the instant claims 1 and 4.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Examiner

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